

REMARKS

I. Introduction

Claims 1 to 21 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to the Drawings

The drawings were objected to under 37 C.F.R. § 1.83(a). The Office Action alleges that the radial locking recess in at least one axial end of the transmission shaft shoulder, as recited in claim 1, and the support gearing, as recited in claim 7, are not shown in the drawings. Applicant respectfully disagrees for the following reasons.

Regarding the claim 7 recitation of “support gearing comprising a radial locking recess in at least one axial end”, the Examiner’s attention is directed to Figure 1 and page 9, lines 18 to 25 of the Specification which states as follows:

Two locking roller elements 15a, 15b rest on one tooth of external **gearing** 7 of synchromesh body 5. On both of its **axial ends**, this tooth is provided with **recesses** 66a, 66b, the depth of which corresponds exactly to the radial depth of pan-shaped recesses 17a, 17b. A crown circle of the tooth leads over edges 64a, 64b and bevels 21a, 21b connected to them into recesses 66a, 66b. Bevels 21a, 21b, like pan walls 19a, 19b, form a 45° angle. (emphasis added).

Therefore, Applicant submits that the drawings show the support gearing 7 and the radial locking recesses 66a and 66b.

Regarding the claim 1 and 16 recitation of “radial locking recess located in at least one axial end of a transmission shaft shoulder,” the Examiner’s attention is directed to the above reference and further directed to Figure 1 and page 4, lines 2 to 8 of the Specification, which states as follows:

Furthermore, due to the roller element support, a small axial installation space is possible for the positive-locking clutch. The reason for this is the possibility of arranging the locking **depression** on the **axial end** of the synchromesh body or a vehicle transmission **shaft shoulder** without the locking roller element falling out of the positive-locking clutch. (emphasis added).

As indicated in the above excerpt, the transmission shaft shoulder is the element shown having a depression or recess on the axial end. Body 5 is shown in Figure 1 as having

recesses 66a and 66b. Given that the drawings show body 5 in a highly schematic fashion and given the discussion in the Specification of the depression being on an axial end of either the vehicle transmission shaft shoulder or the synchromesh body, Applicant respectfully submits that body 5 may be either a transmission shaft shoulder or a synchromesh body. Therefore, Applicant respectfully submits that the drawings show all of the features claimed. Accordingly, withdrawal of the objection to the drawings is respectfully requested.

III. Objection to the Specification

The Specification was objected to for allegedly defining the term “synchromesh body” in a manner that is repugnant to the usual meaning of the term. See Office Action at p. 2. The Office Action further alleges that the term is used in the claims to mean a “hub” while the accepted meaning is “a component used to synchronize gears at the same speeds before engaging to effect a smooth shift”. See Office Action at p. 4. Applicant respectfully submits that the synchromesh body is illustrated in a highly schematic manner and that there is absolutely nothing in the Specification or claims which precludes the synchromesh body from being “a component used to synchronize gears at the same speeds before engaging to effect a smooth shift”. Therefore, withdrawal of the objection to the Specification is respectfully requested.

IV. Rejection of Claims 1 to 4, 6, 8 to 14 and 16 to 18 Under 35 U.S.C. § 112, 1st ¶

Claims 1 to 4, 6, 8 to 14, and 16 to 18 were rejected under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Office Action contends that the Specification does not support the claim 1 and 16 recitation of a “radial locking recess located in at least one axial end of a transmission shaft shoulder” and the claim 7 recitation of “support gearing comprising a radial locking recess in at least one axial end”.

As an initial matter, the Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects

a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). However, the written description requirement is not an *in haec verba* requirement. That is, “the specification ‘need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.’” All Dental Prodx LLC v. Advantage Dental Products Inc., 64 U.S.P.Q.2d 1945, 1948 (Fed. Cir. 2002) (quoting Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995)). Moreover, a “failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” All Dental Prodx, 64 U.S.P.Q.2d at 1948 (citing Eiselstein, 52 F.3d at 1039, 34 U.S.P.Q.2d at 1470). An applicant can show “possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.” M.P.E.P. § 2163 (citing Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997)).

Regarding the claim 7 recitation of “support gearing comprising a radial locking recess in at least one axial end”, as indicated above, the Examiner’s attention is directed to page 9, lines 18 to 25 of the Specification which states as follows:

Two locking roller elements 15a, 15b rest on one tooth of external **gearing** 7 of synchromesh body 5. On both of its **axial ends**, this tooth is provided with **recesses** 66a, 66b, the depth of which corresponds exactly to the radial depth of pan-shaped recesses 17a, 17b. A crown circle of the tooth leads over edges 64a, 64b and bevels 21a, 21b connected to them into recesses 66a, 66b. Bevels 21a, 21b, like pan walls 19a, 19b, form a 45° angle. (emphasis added).

Regarding the claim 1 and 16 recitation of “radial locking recess located in at least one axial end of a transmission shaft shoulder” the Examiner is directed to the above reference and, as indicated above, further directed to page 4, lines 2 to 8 of the Specification, which states as follows:

Furthermore, due to the roller element support, a small axial installation space is possible for the positive-locking clutch. The reason for this is the possibility of arranging the locking **depression** on the **axial end** of the synchromesh body or a vehicle transmission **shaft**

shoulder without the locking roller element falling out of the positive-locking clutch. (emphasis added).

Accordingly, Applicant respectfully submits that a person skilled in the art would recognize both the support gearing and the transmission shaft shoulder, recited in claims 1, 7 and 16, as supported by an adequate written description of elements referenced in the Specification upon which the roller elements 15a, 15b roll. Further, Applicant submits that a person skilled in the art would recognize the axial end of the transmission shoulder, as recited in claim 1, as supported by an adequate written description of the location of recesses 66a, 66b, as disclosed on p. 9, lines 18 to 25, and/or the location of the depression, disclosed on page 4, lines 2 to 8. Therefore, withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 1 to 4, 6, 8 to 14 and 16 to 18 is respectfully requested.

V. Rejection of Claims 1 to 21 Under 35 U.S.C. § 112, 2nd ¶

Claims 1 to 21 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. The Office Action alleges that the term “synchromesh body” is indefinite because Applicant is allegedly using this term to mean a “hub” in claim 5 and using its alleged accepted meaning of “a component used to synchronize gears at the same speeds before engaging to effect a smooth shift”, in claims 1 and 7. See Office Action at p. 4. Applicant respectfully disagrees for the following reasons.

The second paragraph of 35 U.S.C. § 112 merely requires that the claims set out and circumscribe a particular subject matter with a *reasonable* degree of clarity and particularity. Claim 5 recites that the at least one locking roller element is displaceable into a radial locking recess in an axial end of a synchromesh body in accordance with a radial force component with axial displacement of the sliding sleeve. Nowhere does claim 5 specifically state that the synchromesh body is a “hub” and not “a component used to synchronize gears at the same speeds before engaging to effect a smooth shift.” Accordingly, Applicant submits that there is no contradiction between the use of the term “synchromesh body” in claim 5 and claim 1 and 7. Accordingly, withdrawal of this rejection and allowance of claims 1 to 20 is respectfully requested.

VI. Rejection of Claims 1 to 4, 6 to 14 and 16 to 18 Under 35 U.S.C. § 102(b)

Claims 1 to 4, 6 to 14 and 16 to 18 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,303,151 ("Kolacz"). It is respectfully submitted that Kolacz does not anticipate claims 1 to 4, 6 to 14 and 16 to 18 for the following reasons.

Independent claims 1 and 7 relate to a gear-jumping-proof positive-locking clutch configured to connect a motor-vehicle transmission shaft to a transmission component mounted coaxially and rotatably with respect to the transmission shaft. Claims 1 and 7 recite a gear-jumping-proof positive-locking clutch including at least one axially displaceable locking roller element and an axially displaceable sliding sleeve configured to support the at least one locking roller element. Claim 1 further recites that the at least one locking roller element is displaceable into a radial locking recess in at least one axial end of a transmission shaft shoulder. Claim 7 further recites at least one locking roller element displaceable into a radial locking recess in an axial end of a support gearing.

Kolacz purportedly relates to a positive locking mechanism on a shift coupler for a vehicle transmission. See Abstract. The mechanism is stated to include a clutch sleeve with a radial opening for receiving balls which lock the clutch sleeve. Figures 2 and 3 show two balls or detent elements 32 and 33 which are receivable in a centered recess 31. Figures 4 and 5 show one ball or detent element 45, which are receivable in three recesses 42, 43 and 44. Recess 43 is stated to be a central recess. See col. 2, line 49. As shown in Figures 4 and 5, recess 42 is formed on clutch hub 41 between central recess 43 and an axial end of clutch hub 41. Further as shown in Figures 4 and 5, recess 44 is formed on clutch hub 41 between central recess 43 and an opposite axial end of clutch hub 41.

The Office Action alleges that Kolacz discloses a locking roller element that is displaceable into a radial recess (31). See Office Action at p. 5. The Office Action does not allege, however, nor does Kolacz disclose, or even suggest, a radial locking recess in at least one **axial end** of a transmission shaft shoulder, as recited in claim 1, or a radial locking recess in at least one **axial end** of a support gearing, as recited in claim 7. As stated above, in Kolacz the recesses are either centered or located between an axial end of clutch hub 41 and the center of clutch hub 41. Therefore, Applicant respectfully submits that Kolacz does not disclose all of the limitations of independent claims 1 and 7.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention

must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Kolacz does not disclose, or even suggest, a radial locking recess in at least one axial end of a transmission shaft shoulder, as recited in claim 1, or a radial locking recess in at least one axial end of a support gearing, as recited in claim 7. It is therefore respectfully submitted that Kolacz does not anticipate independent claims 1 and 7.

In summary, it is respectfully submitted that Kolacz does not anticipate amended independent claims 1 and 7. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 1 and 7 is respectfully requested.

As for claims 2 to 4, 6, 8 to 14 and 16 to 18, which ultimately depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that Kolacz does not anticipate these dependent claims for at least the same reasons provided above in support of the patentability of claim 1. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 2 to 4, 6, 8 to 14 and 16 to 18 is respectfully requested.

VII. Allowable Subject Matter

Applicant notes with appreciation the indication that claims 5, 15 and 19 to 21 contain allowable subject matter. As more fully set forth above, Applicants respectfully submit that the rejection under 35 U.S.C. § 112, second paragraph has been obviated. In view of the foregoing, Applicant respectfully submits that claims 5, 15 and 19 to 21 are in condition for immediate allowance.

VIII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: October 7, 2003

By:

Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

Richard L. Mayer
Reg. No. 22,490